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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,754	04/09/2004	John Edward O'Neill	JEO-00101	1868
28960 7590 06/11/2007 HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			EXAMINER MENDIRATTA, VISHU K	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 06/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,754	Applicant(s) O'NEILL, JOHN EDWARD	
	Examiner Vishu K. Mendiratta	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12,33,34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4,7-9,12 rejected under 35 U.S.C. 102(b) as being anticipated by Nolte (3610626)

Claims 1,7,12: Nolte teaches a game board (Fig.4) comprising a plurality of game pieces, a plurality of first game pieces designated by a first type (Kings), a plurality of second game pieces designated by a second type (pawn), a plurality of third type game pieces designated by a third type (bishop), a plurality of forth type game pieces designated by a forth type (rooks), a plurality of fifth game pieces designated by a fifth type (knight), a plurality of sixth game pieces designated by a sixth type (queens),and a seventh game piece (46) wherein a all four queens are different in colors and further the game board comprising outer (peripheral) and inner squares.

The limitation "designated", "associated with" are treated as "rule for playing" and do not further limit the apparatus as claimed.

Claims 2,8: Nolte game board teaching all game piece types to be configured in different (K, Q, R, B, Kt, P, Guard).

Claims 3,9: Nolte game board having grid of squares (Fig.4,10) at least 8x8.

Claim 4: Nolte teaches outer perimeter and inner area of squares (Fig.4).

2. Claims 7-12 rejected under 35 U.S.C. 102(b) as being anticipated by Weiss (4093237).

Claim 7,12: Weiss teaches a game board (Fig.2) comprising a plurality of game pieces, a plurality of first game pieces designated by a first type (Kings), a plurality of

second game pieces designated by a second type (pawn), a plurality of third type game pieces designated by a third type (bishop), a plurality of forth type game pieces designated by a forth type (rooks), a plurality of fifth game pieces designated by a fifth type (knight), a plurality of sixth game pieces designated by a sixth type (queens), wherein a all four queens are different in colors and further the game board comprising outer (peripheral) and inner squares.

The limitation "associated with" is treated as "rule for playing" and does not further limit the apparatus as claimed.

Claim 8: Weiss game board teaching all game piece types to be configured in different (K, Q, R, B, Kt, P, Guard).

Claim 9: Weiss game board having grid of squares (Fig.2) at least 8x8.

Claim 10: Weiss teaches a die as a randomizer means (4:38).

Claim 11: Weiss game pieces are capable of being designated as tree types.

Designations are intended use and not further limiting apparatus claims.

Claim Rejections - 35 USC § 103

4. Claims 5-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte in view of Weiss.

Claim 5: Nolte teaches all limitations except that it does not provide a randomizer. Weiss teaches providing a randomizer. It is well known in the art area of board games to determine the first player to start the game. There are numerous known methods to determine the first player, including determining using a chance device. Such a method eliminates any conflict and acceptable to every player. In order to start a game in

orderly manner, it would have been obvious to modify Nolte to provide a randomizer. One of ordinary skill in art at the time the invention was made would have suggested modifying Nolte to provide a randomizer to start the game in an orderly manner.

Claim 6: Nolte game pieces are capable of being designated as tree types.

Designations are intended use and not further limiting apparatus claims.

5. Claims 33,34 rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte. Nolte teaches all limitations except that it does not teach first type of game pieces in a specific shape. Examiner takes the position that game piece shapes are configured according to personal preferences that are aesthetically pleasing. The art area of game boards is an amusement art area and in order to attract players it would have been obvious to configure game pieces aesthetically pleasing. One of ordinary skill in art at the time the invention was made would have suggested configuring specific shapes for game pieces to attract potential players.

Response to Arguments

Applicant's arguments with respect to claims 1-12,33,34 have been considered but are moot in view of the new ground(s) of rejection.

Applicant may note again that rules for playing a game, method steps and intended use terminology do not further limit a claimed apparatus. For example "designating a game piece" is interpreted as giving a name to a game piece and "associating a game piece" is interpreted as a method step having no apparatus structure.

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

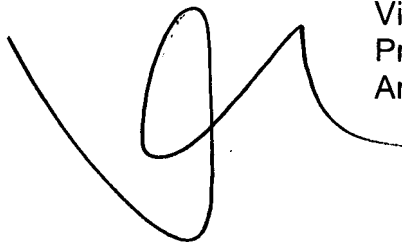
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, consisting of a large, stylized 'V' followed by a series of loops and a final upward stroke.

Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKM
June 6, 2007